PATENT
Attorney Docket No. 05793.3065-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Keira Brooke Bard et al.	)	Group Art Unit: 3694
	)	
Serial No.: 09/880,777	)	Examiner: Ojo Oyebisi
	)	
Filed: June 15, 2001	)	Confirmation No.: 7834
	)	
For: SYSTEM AND METHODS FOR PROVIDING STARTER CREDIT CARD ACCOUNTS	)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the rejections in the Final Office Action mailed on July 19, 2007. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

This Pre-Appeal Brief request for review follows the Examiner's Advisory Action mailed October 23, 2007.

Claims 1-12, 14-28, 30-40, 42-58, 60-88 and 90-120 are pending, under current examination. In the Final Office Action, the Examiner rejected claims 1-12, 14-28, 30-40, 42-58, 60-88 and 90-120 under 35 U.S.C. § 103(a) as allegedly unpatentable over *Sears* ("Sears Tests Starter Card," Card Fax News Brief) in view of U.S. Patent No. 6,018,718 to Walker et al. ("*Walker*").

I. Claims 76, 106, and 117

Claim 76, for example, recites a computer-readable medium including, *inter alia*, instructions for performing a method including "changing the second interest rate to a third interest rate that is higher than the first interest rate, when it is determined that the customer has made the predetermined number of on-time payments associated with the second credit account" (emphasis added).

In a non-final Office Action mailed January 29, 2007, the Examiner rejected claim 76 under 35 U.S.C. § 112, second paragraph, alleging that "changing the second interest rate to a third interest rate that is higher than the first interest rate ... would go against the whole premise of the claimed invention" (Office Action at pp. 3-4). The Examiner incorrectly interpreted the claim to require "changing the second interest rate to a third interest rate that is **lower** than the first interest rate" (emphasis in original) (Office Action at p. 4). The Examiner also rejected claim 76 under 35 U.S.C. § 103(a), citing to *Walker's* disclosure of a "reduced APR" when addressing the claimed "interest rate that is higher than the first interest rate" (emphasis added)(Office Action at p. 23).

In a Reply to Office Action filed April 20, 2007, Applicants addressed the 35 U.S.C. § 112 rejection by pointing out that claim 76 is fully supported by the specification, and requested that the Examiner examine claim 76 as presented (Reply to Office Action at pp. 5-6). In addressing the 103(a) rejection, Applicants also pointed out that *Walker* did not disclose the claimed "third interest rate that is higher than the first interest rate" (Office Action at p. 17).

In the Final Office Action mailed July 19, 2007, the Examiner withdrew the 35 U.S.C. § 112 rejection of claim 76 (Final Office Action at p. 2). However, the Examiner continued to rely on *Walker's* disclosure of a "reduced APR" when addressing the claimed "third interest rate that is higher than the first interest rate" (Final Office Action at p. 22), suggesting that the Examiner was continuing to misconstrue claim 76.

Applicants' representative conducted an after-final interview with the Examiner on August 15, 2007, and explained that a "reduced APR" is not the same as a change "to a third interest rate that is higher than the first interest rate." In the interview, the Examiner conceded that *Walker* does not disclose this recitation of claim 76. The Examiner agreed to remedy this deficiency upon receiving this response after final.

Applicants filed a Request for Reconsideration on August 30, 2007, and again pointed out the deficiencies of *Walker* and the Examiner's misreading of claim 76. The Examiner's Advisory Action mailed October 23, 2007 contains no mention of claim 76.

In sum, Applicants have pointed out the deficiencies of *Walker* on several occasions. Yet, the Examiner continues to address the recitations of claim 76 by citing to portions of *Walker* which are contrary to the claimed subject matter. While the Examiner withdrew the 35 U.S.C. § 112 rejection, it appears that the Examiner continues to

improperly interpret claim 76. While the Examiner is entitled to interpret claims broadly, such interpretation cannot be unreasonable (M.P.E.P. § 2111).

Therefore, the rejection of claim 76 is legally deficient for at least two reasons. First, the Examiner continues to misconstrue the recitations of claim 76. Moreover, the Examiner has not demonstrated that the cited references render obvious a method including "changing the second interest rate to a third interest rate that is higher than the first interest rate, when it is determined that the customer has made the predetermined number of on-time payments associated with the second credit account" (emphasis added).

Accordingly, the Examiner has not demonstrated that the cited art, either alone or in combination, renders obvious the recitations of claim 76. The Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, no reason has been clearly articulated as to why the claim 76 would have been obvious to one of ordinary skill in view of *Sears* and *Walker.* Therefore, the Examiner has not established a *prima facie* case of obviousness, and the rejection of claim 76 under 35 U.S.C. § 103(a) is legally deficient and should be withdrawn and the claim allowed.

Claims 106 and 117 each includes recitations similar to those of claim 76. As explained, the cited art does not support the rejection of claim 76. As such, the cited art does not support the rejection of claims 106 and 117 for at least the same reasons set forth in connection with the response to the rejection of claim 76.

For at least these above reasons, the Examiner has not established a *prima facie* case of obviousness, and Applicants request that the rejections of claims 76, 106, and 117 under 35 U.S.C. § 103(a) be withdrawn, and the claims allowed.

II. Claims 37-40

A. The Examiner Has Improperly Relied Upon Official Notice

Claim 37 recites a process for monitoring a starter credit account including, *inter alia*, "a process for resetting the trial period when the activity reflects that the customer has not met the predetermined criteria."

In a final Office Action mailed July 19, 2006, the Examiner rejected claim 37 under 35 U.S.C. § 102(b) as anticipated by *Sears*, but conceded that *Sears* failed to disclose this recitation of claim 37 (Final Office Action at pp. 2, 18). The Examiner apparently took

Official Notice in rejecting claim 37, stating that "it is common sense to know that if the trial period leaves the customer in poor account standing ... the customer would be penalized and have his account downgraded" (Final Office Action at p. 18).

In the Amendment filed December 19, 2006, Applicants traversed the taking of Official Notice (Amendment at p. 54). In the Office Action mailed January 29, 2007, the Examiner rejected claim 37 under 35 U.S.C. § 103(a) as unpatentable over *Sears* in view of *Walker*, but conceded that *Sears* and *Walker* fail to disclose this recitation of claim 37 (Office Action at pp. 5, 17-18). Again, the Examiner alleged that "it is common sense to know that if the trial period leaves the customer in poor account standing ... the customer would be penalized and have his account downgraded" (Office Action at p. 18). The Examiner made no mention of Applicants' traversal of the Official Notice, stating only that Applicants' arguments were "moot in view of the new ground(s) of rejection" (Office Action at p. 28).

In the Reply to Office Action filed April 20, 2007, Applicants again traversed the Official Notice (Reply to Office Action at p. 16). In the Final Office Action mailed July 19, 2007, the Examiner again rejected claim 37 under 35 U.S.C. § 103(a) as unpatentable over *Sears* in view of *Walker*, again alleged that "common sense" justified the rejection, and again made no mention of Applicants' traversal of the Official Notice (Final Office Action at pp. 2-3, 15-17).

Finally, in the interview held August 15, 2007, the Examiner agreed that the failure to respond to Applicants' traversal of Official Notice was improper. Consequently, the Examiner agreed to address this issue in the next USPTO communication. As appears in the Request for Reconsideration filed August 30, 2007, Applicants again requested the Examiner to address the Official Notice, and again traversed the Official Notice (Request for Reconsideration at pp. 4, 15-16).

Yet, the Advisory Action mailed October 23, 2007, contains no mention of claim 37 or the Official Notice.

In short, each time Applicants have traversed the Official Notice, the Examiner has declined to comply with M.P.E.P. 2144.03, which states that "[i]f applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection." Here, Applicants have adequately traversed the Official Notice three separate times. Each time, the Examiner

has not only failed to provide a reference, the Examiner has not even mentioned the Official Notice or Applicants' traversal of the Official Notice in an Office Action. As a result, the Examiner has not provided evidence that supports the assertion that claim 37 is obvious. Thus, the rejection of claim 37 is legally deficient and should be withdrawn.

B. The Finality of the Office Action is Improper

Applicants have amply demonstrated that the Examiner's taking of Official Notice is improper, and the Examiner has failed to comply with relevant M.P.E.P. sections regarding Official Notice. Moreover, because the Examiner failed to address Applicants' position on the Official Notice, the finality of the Office Action mailed 7/19/2007 is improper and should be withdrawn.

MPEP § 707(f) states, "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Here, the Examiner has continually failed to address Applicants' traversal of the Official Notice. Accordingly, the Final rejection of claims 37-40 is improper and should be withdrawn.

III. Claims 1-12, 14-28, 30-36, 42-58, 60-75, 77-88, 90-105, 107-116, and 118-120

Applicants respectfully traverse the rejection of claims 1-12, 14-28, 30-36, 42-58, 60-75, 77-88, 90-105, 107-116, and 118-120 for at least the reasons discussed in the Request for Reconsideration filed August 30, 2007.

IV. Conclusion

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 16, 2007

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